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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|-----------------|-------------|----------------------|---------------------|------------------|
| 09/768,274 | 01/25/2001 | Werner Temme | 24487 | 3642 |

7590 04/09/2003

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EXAMINER

NILAND, PATRICK DENNIS

| ART UNIT | PAPER NUMBER |
|----------|--------------|
|----------|--------------|

1714

15

DATE MAILED: 04/09/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

| | | | |
|------------------------------|-------------------------------|------------------------------|--|
| Office Action Summary | Application No. 09/768,274 | Applicant(s) TEMME ET AL. | |
| | Examiner Patrick D. Niland | Art Unit 1714 | |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 22 January 2003.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 18-38 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 18-38 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ | 6) <input type="checkbox"/> Other: _____ |

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1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless -

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claims 18-22, 25-27, 30, 32, 34, and 36-38 are rejected under 35 U.S.C. 102(e) as being anticipated by US Pat. No. 6218500 Keute et al..

Keute et al. discloses a method of covering a floor with a composition falling within the scope of the instant claims. Organic solvent is not required and any ketone used is removed. The solids content falls within the scope of the instant claims. See the abstract; column 1, lines 44-55; column 3, lines 5-17; column 6, lines 40-45; column 9, lines 50-67; and the remainder of the document. Though "sports floor" is not specified, one can play "sports" on any floor. This preambular phrase therefore does not distinguish over the method of the instant claims. The patentee is silent regarding the particle size of the urethane disclosed therein. The burden is on

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the applicant to show that it does not inherently possess the instantly claimed particle size because its molecular weight and ionic group content would indicate that it would possess a very small particle size and dispersed urethanes are typically of 20 nm to 5 micrometers.

The argument regarding the number of steps in making the polyurethane is not persuasive because the instant claims do not exclude such steps. If one includes all of the steps required to make all components of a urethane, there are many steps. The polyurethane of the prior art is NCO free, which is what the instant claims require. The instant claims encompass copolymers as they are not excluded. The instant claims recite “comprising” and therefore encompass additional steps and ingredients.

4. Claims 18-38 are rejected under 35 U.S.C. 103(a) as being unpatentable over US Pat. No. 6218500 Keute et al..

Keute et al. discloses a method of covering a floor with a composition falling within the scope of the instant claims. Organic solvent is not required and any ketone used is removed. The solids content falls within the scope of the instant claims. See the abstract; column 1, lines 44-55; column 3, lines 5-17; column 6, lines 40-45; column 9, lines 50-67; and the remainder of the document. Though “sports floor” is not specified, one can play “sports” on any floor. This preambular phrase therefore does not distinguish over the method of the instant claims. The patentee is silent regarding the particle size of the urethane disclosed therein. The burden is on the applicant to show that it does not inherently possess the instantly claimed particle size because

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its molecular weight and ionic group content would indicate that it would possess a very small particle size and dispersed urethanes are typically of 20 nm to 5 micrometers.

It would have been obvious to one of ordinary skill in the art at the time of the instant invention to add the additives of the instant claims 24, 28, 29, 31, 34, and 35 because these additives will give their well known properties to the polymer matrix of the patentee. It would have been obvious to one of ordinary skill in the art at the time of the instant invention to spray the coating of the patentee on the floor because this is a conventional method of coating things with an aqueous dispersion. It would have been obvious to one of ordinary skill in the art at the time of the instant invention to use the composition of the patentee as an adhesive according to the instant claim 33 because it is known to be adhesive from column 1, lines 10-13 and its properties such as tensile strength and flexibility would have been expected in the laminate resulting therefrom. It would have been obvious to one of ordinary skill in the art at the time of the instant invention to use the molecular weight of the instant claim 23 because the patentee states that choice of molecular weight is within the ability of the ordinary skilled artisan at column 8, lines 42-48 and molecular weight gives only predictable properties such as viscosity by definition of viscosity average molecular weight and modulus.

The argument regarding the number of steps in making the polyurethane is not persuasive because the instant claims do not exclude such steps. If one includes all of the steps required to make all components of a urethane, there are many steps. The polyurethane of the prior art is NCO free, which is what the instant claims require. The instant claims encompass copolymers as

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they are not excluded. The instant claims recite “comprising” and therefore encompass additional steps and ingredients. The other arguments of the applicant with regard to this rejection are not persuasive for the reasons set forth above, which are clear on their face.

5. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

6. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Patrick Niland whose telephone number is (703) 308-3510. The examiner can normally be reached on Monday to Friday from 9:30 to 6:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner’s supervisor, Vasu Jagannathan, can be reached on (703) 306-2777. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9310 before final and (703) 872-9311 after final.

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Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0661.

pn

April 6, 2003

A handwritten signature in black ink, appearing to read 'Patrick Niland', is written over the printed name.

Patrick Niland
Primary Examiner
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